

Art Unit 2186
Serial No.10/004,100

Reply to Office Action of: August 4, 2005
Attorney Docket No.: K35A0989

AMENDMENTS TO THE DRAWINGS

The attached sheet of drawings includes changes to Fig. 1, and replaces the original sheet.

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REMARKS

The Applicant thanks the Examiner for his careful and thoughtful examination of the present application. By way of summary, Claims 1-24 were pending in this application. In the present amendment, the Applicant has amended Figure 1 in the drawings, and Claims 1, 4, 5, 12, 14 and 17. Accordingly, Claims 1-24 remain pending for consideration.

Information Disclosure Statement

The Applicant filed an Information Disclosure Statement and accompanying Form PTO/SB/08A citing 2 references on July 25, 2005. The Applicant notes that Form PTO/SB/08A was not returned nor was inclusion of the same marked on the Office Action Cover Sheet. The Applicant respectfully requests that the IDS be properly considered, and a copy of the submitted Form PTO/SB/08A including an indication of the consideration be returned in a next communication from the Patent Office.

Response To Drawing Objections

The Office action objected to the drawings, requesting that the unlabeled elements in Figure 1 be provided with descriptive text labels. Figure 1 has been replaced in the attached document to add these descriptive text labels.

The drawing amendments are supported throughout the originally filed specification. Accordingly, the Applicant respectfully submits that no new matter is introduced by the proposed drawing changes and therefore respectfully requests that the Examiner withdraw the objection to the drawings.

Rejection Of Claims 5, 17 and 24 Under 35 U.S.C. § 112, Second Paragraph

The specific rejections made by the Examiner, and Applicant's response to these rejections are discussed below.

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Claims 5 and 17

With respect to Claims 5 and 17, the Examiner has stated that the limitation "wherein information" lacks sufficient antecedent basis. The Applicant has amended Claims 4 and 14 to recite "a second range of addressable locations used to store information." Claims 5 and 17 have also been amended to recite "the information." These claim clarifications are not made for patentability purposes, and it is believed that the claims would satisfy the statutory requirements for patentability without the entry of such clarifications. Withdrawal of the rejection of Claims 5 and 17 under 35 U.S.C. § 112, second paragraph is requested.

Claim 24

With respect to Claim 24, the Examiner has stated that the limitation "a command validation key" also lacks sufficient antecedent basis. Applicant respectfully submits that "command validation key" is used for the first time in the claims in Claim 24 and need not have antecedent basis.

The Examiner has also stated that it is unclear whether this phrase in method Claim 24 is intended to be the same as or different from the "key" recited in disk drive Claim 9. Applicant respectfully submits that the two terms are sufficiently different that no confusion will result. Moreover, Claim 9 depends from independent Claim 1, whereas Claim 24 depends from independent Claim 12. There is no need for these terms to relate, as neither claim depends from the other. Withdrawal of the rejection of Claim 24 under 35 U.S.C. § 112, second paragraph is requested.

Rejection Of Claims 1-8, 10-17, 22 and 24 Under 35 U.S.C. § 102

The Office action rejected Claims 1-8, 10-17, 22 and 24 under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 6,772,281, issued to Hamlin (the Hamlin patent). It is noted that the Office action recited § 102(b), but Applicant respectfully submits that the Hamlin patent, first published on November 7, 2002, was not "patented or described in a printed publication in this or a foreign country . . . more than one year prior to the date of application for patent [October 31, 2001]," as required by § 102(b).

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Regardless, the Applicant respectfully traverses this rejection because the Hamlin patent fails to identically disclose every element of the rejected claims.

For example, amended independent Claim 1 recites "a mailbox file executable under control of the disk drive . . . [and] a disk controller . . . to perform a function characterized by contents of the mailbox file." The Hamlin patent does not disclose these limitations.

The Examiner asserts that the claimed mailbox file corresponds to the first data block disclosed by Hamlin. However, as amended, Claim 1 now recites that the mailbox file is "executable under the control of the disk drive." While, *inter alia*, the Hamlin patent does disclose that "[t]he information [stored in such data blocks] can be blocks of data, such as audio/video data, or can be executable code," the Hamlin patent further discloses that "[i]nformation stored at the substitute location is returned to the requesting host in satisfaction of the host's request." Col. 2, II. 60-63. The Hamlin patent does not disclose a mailbox file "executable under the control of the disk drive."

The Examiner further asserts that the disk controller disclosed by Hamlin performs a function characterized by contents of the mailbox file, citing Col. 5, lines 54-57 of the Hamlin patent. In fact, this passage of the Hamlin patent reads, "[t]he disk drive is not limited to substituting alternate executable code, but rather can be configured to include a facility for detecting the presence of requests referencing any predetermined storage location of the disk (e.g., a location storing data representing audio/video information to be displayed on the host monitor) and in response thereto, substitute content selected by the drive's translation map." Col. 5, lines 52-58. Contrary to the Examiner's assertions, this portion of the Hamlin patent does not disclose a disk controller to perform a function characterized by contents of the mailbox file.

Amended Claim 12 recites "a mailbox file executable under control of the disk drive . . . [and] performing a function characterized by contents of the mailbox file." The Hamlin patent does not disclose these limitations.

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As discussed above, Hamlin does not disclose "a mailbox file executable under control of the disk drive." Similarly, as discussed above, Hamlin does not disclose "performing a function characterized by contents of the mailbox file."

For at least these reasons, Applicant respectfully submits that the § 102 rejections are improper and requests that they be withdrawn.

Dependent claims 2-11 and 13-24 are dependent upon allowable independent claims, and the rejections of these claims should be withdrawn for at least the same reasons given above.

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CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully submits that the pending claims are now in condition for allowance and requests reconsideration of the rejections. If it is believed that a telephone conversation would expedite the prosecution of the present application, or clarify matters with regard to its allowance, the Examiner is invited to contact the undersigned attorney at the number listed below.

The Commissioner is hereby authorized to charge payment of any required fees associated with this Communication or credit any overpayment to Deposit Account No. 23-1209.

Respectfully submitted,

By: _____

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APPENDIX